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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,153	03/29/2006	Wolfgang von Deyn	13779-61	2172
45473 7590 11/18/2009 BRINKS, HOFER, GILSON & LIONE P.O. BOX 1340 MORRISVILLE, NC 27560			EXAMINER LOEWE, SUN JAE Y	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 11/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,153	Applicant(s) DEYN ET AL.	
	Examiner SUN JAE Y. LOEWE	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,24-29 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19,24-29,32-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 19, 24-29 and 32-39 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9, 2009 has been entered.

Response to Amendment

3. The amendments to the claims filed on September 9, 2009 have been fully considered. The 35 USC 103 rejection has been obviated and is thus hereby withdrawn.
4. Notwithstanding non-allowability of the generic product claims (see below Sections 5 and 6), the search and examination was extended to the full scope of claimed compounds. Furthermore, previously withdrawn process claims 33-37 were rejoined and fully examined for patentability.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement as set forth in the Office action mailed on November 15, 2007 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory

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and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

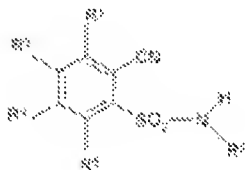
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 19, 24-29 and 32-39 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19, 20 and 22-35 of copending Application No. 11/909,447. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Determination of the scope and contents of claims 19, 20 and 22-35 of US Appl. 11/909,447.

The claims are drawn to a seed comprising a Markush group of compounds with the same utility as that instantly claimed and process of using.



The instant elected species (ie. compound 66, Section 2) is a disclosed preferred embodiment of 11/909,447 (specification pg. 60).

Ascertaining the differences between claim claims 19, 20 and 22-35 of US Appl. 11/909,447 and the claims at issue.

The embodiment anticipates the instant claims.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states “...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties”. This is a “Genus-Species Guidelines” for the examination

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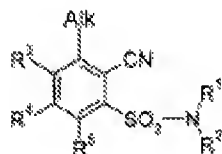
based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

The embodiment suggests to one of ordinary skill to practice the instant claims. Thus, the instant claims are *prima facie* obvious over claims 19, 20 and 22-35 of US Appl. 11/909,447.

6. Claims 19, 24-29, 32, 38 and 39 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,544,637. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

Determination of the scope and contents of claims 1-8 of US 7,544,637

The claims are drawn to a Markush group of compounds with the same utility as that instantly claimed.



Embodiments disclosed include, for example, the species wherein

Example	R ¹	R ²	Alk	R ³	R ⁴	m.p. [°C]*/ 1H-NMR**/ LC-MS***
No. 9	C ₂ H ₅	C ₂ H ₅	OCH ₂ CH ₃	H	H	Oil

Ascertaining the differences between claims 1-8 of US 7,544,637 and the claims at issue.

The embodiment is a homolog of the instantly elected compound: ie. sulphonamide nitrogen is substituted with ethyl (species in copending application) vs. hydrogen (species of the instant election).

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states “...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties”. This is a “Genus-Species Guidelines” for the examination

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based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

The embodiment suggests to one of ordinary skill to practice. Thus, the instant claims are *prima facie* obvious over claims 1-8 of US 7,544,637.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Golam M. M. Shameem/
Primary Examiner, Art Unit 1626

/Sun Jae Y. Loewe/
11-12-2009